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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,978	02/08/2002	Vincent J. Gatto	EP-7532	3784
7590 04/06/2004				
Mr. Dennis H. Rainear Patent & Trademark Division Ethyl Corporation 330 South Fourth Street Richmond, VA 23219			EXAMINER	
			JOHNSON, JERRY D	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,978	Applicant(s) GATTO, VINCENT J.	
	Examiner Jerry D. Johnson	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 37-40, 42 and 44-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 37-40, 42 and 44-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-28, 37-40, 42 and 44-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciani et al. (5,698,498) combined with Ward, Jr. (4,846,983) or Gatto et al. (6,174,842).

Luciani et al. teach lubricating oil compositions, functional fluids, greases and aqueous compositions comprising at least hydroxyalkyl dithiocarbamate. The lubricants, greases and fluids are said to have improved anti-wear and extreme pressure properties. The hydroxyalkyldithiocarbamate is prepared by reacting an amine, carbon disulfide and an epoxide (note column 2, lines 39-53). Patentee teaches the use of other additives together with the hydroxyalkyldithiocarbamate including other extreme pressure and anti-wear agents. Metal thiocarbamates are specifically taught (column 25, lines 35-40 and column 26, line 46). The additives may include solid lubricants such as molybdenum disulfide (column 30, lines 51-52).

The secondary references (Ward, Jr. and Gatto et al.) teach various molybdenum compounds which are known in the lubricant filed as being conventional extreme pressure/anti-wear additives.

It is the examiner's position that the claimed invention would be obvious to one of ordinary skill in the art because combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be *prima facie* obvious.

With regards to the claims of specific hydroxyalkyl dithiocarbamates, it is the examiner's position that they would be obvious in view of Luciani et al. since they are the reaction product

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of an epoxide, amine and carbon disulfide and the specific reactions used are encompassed by the broad teachings of the reference. No critically has been shown to exist in the selection of the specific reactants. It is no unobvious to follow the teachings of the prior art.

Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive.

Applicant argues

Luciani et al. nowhere specifically exemplifies or describes an actual combination of a hydroxyalkyl dithiocarbamate and molybdenum source in an *oil-based* lubricant composition.

Instead, Luciani et al. describe *aqueous compositions* with an *aqueous* phase containing at least one hydroxyalkyl dithiocarbamate, and functional additives which *may* also be included in such *aqueous* systems. The functional additives that Luciani et al. describe that *may* be included in such *aqueous compositions* may include certain solid lubricants such as molybdenum disulfide, amongst other listed alternatives thereof. (Remarks, page 17).

Applicant's arguments lack merit.

Luciani et al. is not limited to the specific examples. As noted above, Luciani et al. teach the addition of other lubricant additives including, *inter alia*, extreme pressure agents and anti-wear agents (column 25, lines 35-40). In any event, the "oil-soluble, water-insoluble functional additive(s)" taught by Luciani et al. in column 30 lines 46 to column 31, line 15, are taught as typical "oil-soluble, water-insoluble additives which function in conventional oil-based systems as extreme pressure agents, anti-wear agents, load-carrying agents, dispersants, friction modifiers, lubricity agents, etc." (column 30, lines 36-40). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such an additive in the lubricating composition of Luciani et al. because Luciani et al. specifically that such additives may be included in the lubricant composition.

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Applicant argues

none of the relied upon secondary references suggest combining a molybdenum compound together with a hydroxy-substituted dithiocarbamate in lubricant compositions, much less suggest any possible advantages that might arise from that particular combination. (Remarks, page 18).

Applicant further argues

instant claim 26 recites a lubricant composition comprising a hydroxy-substituted dithiocarbamate, a molybdenum source, and a phosphorus source. None of the relied upon primary nor secondary references teach or suggest that presently claimed three-way component combination in a single lubricant composition. (Remarks, page 19).

Applicant's arguments lack merit.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues

regarding instant claims 38-40, 42, and 44-49 in particular reciting specific hydroxy-substituted dithiocarbamate compounds or lubricating compositions containing a specific hydroxy-substituted dithiocarbamate compound, Applicant submits that the rejection of these claims is improper because the Office Action provides no [sic] sufficient explanation of the structural prima facie obviousness of the recited compounds with reference to any specific hydroxy-substituted dithiocarbamate compounds that may be described in the prior art. (Remarks, page 19).

Applicant's argument lacks merit.

As noted above, Luciani et al. teach forming a hydroxy-substituted dithiocarbamate lubricant additive by reacting an epoxide, amine and carbon disulfide. See column 2, line 38 to column 6, line 50. Accordingly, the prior art discloses the general reaction and compounds of

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the claims. Extension of the reaction to the specific compounds of the claims would be well within the skill of an artisan. *In re Schwarze et al.* 190 USPQ 294.

Applicant argues

even if a prima facie case of obviousness had been established against the rejected claims based on the relied upon references (a contention to which Applicant disagrees for at least the reasons explained above), Applicant has already presented objective probative evidence in the instant specification setting forth unexpected results and properties of the presently claimed compositions sufficient to rebut any such prima facie case of obviousness. (Remarks, page 19).

Applicant's argument lacks merit.

The burden of proving unexpected results rests on the party which asserts them. In proving such results, it is not enough just to show that certain results are obtained. The results to be probative of nonobviousness must be shown to have been unexpected to the skilled worker in the art. *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971); *In re Klosak*, 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re Juillard*, 476 F.2d 1380, 177 USPQ 1570 (CCPA 1973). Moreover, it is axiomatic that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims the evidence is offered to support. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971).

The examples of the specification are limited to specific compositions while the claims are not so limited. Accordingly, the showing is not commensurate in scope with the claims. Additionally, the showing was not generated by a comparison against the cited prior art. Clearly applicant has not carried the burden of proving unexpected results.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

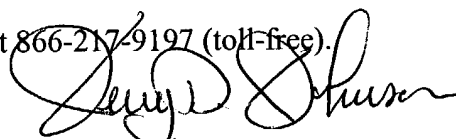
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jerry D. Johnson
Primary Examiner
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